

### **REMARKS**

Following entry of the Amendment, claims 1-5, 7-12, 14-19, 21, 22 and 25 are pending in the above-identified application. Claims 1-5, 7-12, 14-19, 21 and 22 are rejected under 35 U.S.C. §103(a) as being anticipated by Gulati et al. (U.S. Pat. No. 6,924,827; hereinafter referred to as “Gulati”) in view of Denoue et al. (U.S. Pat Pub. No. 2003/0051615; hereinafter referred to as “Denoue”). Claim 25 is rejected under 35 U.S.C. §102(e) as being anticipated by Denoue.

Independent claims 1, 8, 15, 21 and 25 have been amended to focus upon a particular aspect of Applicants’ disclosed technology that was not previously claimed, i.e. the generation of previously unrecorded metadata by means of scanning a document. Support for this feature is found in the Specification at ¶[0037]. Applicants submit that these amendments and remarks overcome all of the Examiner’s outstanding rejections and bring the present Application into condition for allowance. Entry of this amendment and a notice of allowance of all the remaining claims are therefore respectfully solicited.

#### **Rejections Based on §102(2)**

Claim 25 is rejected under 35 U.S.C. §102(e) as being anticipated by Denoue. Claim 25 has been amended to focus upon a particular aspect of Applicants’ disclosed technology that was not previously claimed, i.e. the generation of previously unrecorded metadata by means of scanning a document. Therefore, Applicants believe that Denoue no longer anticipates the claim and respectfully request withdrawal of the §102(e) rejection of claim 25.

#### **Rejections Based on §103(a)**

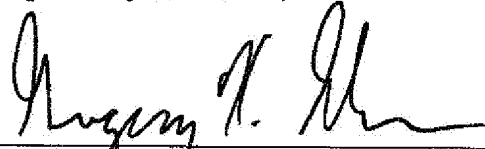
Claims 1-5, 7-12, 14-19, 21 and 22 are rejected under 35 U.S.C. §103(a) as being anticipated by Gulati in view of Denoue. Independent claims 1, 8, 15, 21 and 22 have been amended to focus upon a particular aspect of Applicants’ disclosed technology that was not previously claimed, i.e. the generation of previously unrecorded metadata by means of scanning a document.

To establish *prima facie* obviousness of a claimed invention under §103(a), all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, “**All words in a claim must be considered** in judging the patentability of that claim against prior art.” (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970); *emphasis added*). Applicants believe that the cited art fails to meet this standard. For the reasons above, claims 1, 8, 15 and 21 are allowable over the cited art. In addition, claims 2-5, 7, 9-12, 14 16-19 and 22 are allowable because they each depend upon one of the allowable independent claims.

### **CONCLUSION**

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and earnestly solicits notice thereof. Applicants are not conceding in this application that the unamended claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of the allowable subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. A Request for Continued Examination is being filed and paid for electronically in conjunction with this Amendment/Response. In addition, a Request for a Three-Month Extension of Time is being filed and paid for electronically so that Applicants have until May 14, 2007 to respond. It is believed that no other fees are due with the filing of this Amendment and Request for Continued Examination. However, should any other fees be due, the Commissioner is hereby authorized to charge such fees to the deposit account of IBM Corporation, Deposit Account No. 09-0447.

Respectfully submitted,



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